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| | | Filing Date | February 16, 2001 |
| | | First Named Inventor | Nabkel, Jafar |
| | | Art Unit | 2642 |
| | | Examiner Name | Rasha S. Al Aubaid |
| Total Number of Pages in This Submission | 1 | Attorney Docket Number | 020366-066900 |

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Remarks

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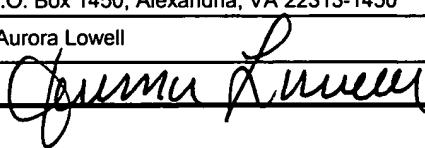
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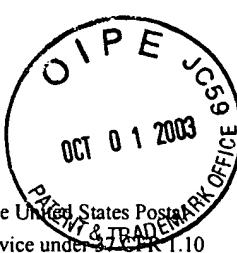
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By: Aurora Lowell

Aurora Lowell

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Jafar Nabkel, *et al.*

Application No.: 09/785,863

Filed: February 16, 2001

For: METHOD AND SYSTEM FOR
PROVIDING PRESELECTED INFORMATION
SERVICES UPON DETECTION OF AN OFF-
HOOK CONDITION

Examiner: Rasha S. Al Aubaidi

Art Unit: 2642

RESPONSE TO EXAMINER'S BRIEF
UNDER 37 CFR §1.193(b)(1)

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U. S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

The following is Appellant's Response to the Examiner's Answer submitted in triplicate pursuant to 37 C.F.R. §1.193(b)(1). Appellant's Appeal Brief was submitted on June 13, 2003. Examiner's Answer was mailed on August 11, 2003, Paper No. 23.

In its appeal brief filed June 13, 2003, Appellants argued that none of the cited references discloses, teaches or suggests "in response to [an] off-hook condition, generating a message corresponding to ... selected information services for receipt by [a] subscriber." The information services are provided according to criteria established by the subscriber, which includes the "frequency" for delivering the services (claim 38) or the "time, date, or day of the week" for delivering the services (claims 1, 16, and 27).



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Appellants also argued that there is no motivation to combine the cited art in such a way that would render Appellant's claims obvious. It is well established that to find a claim obvious under 35 U.S.C. §103 three criteria must be met including, first, the cited references must teach all the claim limitations. In re Wilson, 490 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). Second, there must be a suggestion or motivation to combine the references. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) ("the suggestion [or motivation] . . . must be founded in the prior art, not in the applicant's disclosure."); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings or references can be combined only if there is some suggestion or incentive to do so.").

Because the cited art fails to teach, disclose or suggest all the claim limitations, the *prima facie* case of obviousness fails, and the claims at issue should be allowed for at least this reason. Also, because the cited art fails to motivate or suggest a combination that would render Appellant's claims obvious, the *prima facie* case of obviousness fails and the claims at issue should be allowed for at least this additional reason.

The Examiner's Answer avoids squarely addressing either of the flaws identified in Appellant's arguments. In particular, the Examiner simply neglects to cite the motivation necessary to combine the references. Further, with respect to the missing limitations, the Examiner's Answer is tantamount to an admission that neither Kung nor McLeod teach a "subscriber profile including selected information services."¹ Further still, Appellant disagrees with the Examiner's suggestion that McLeod's teachings at column 35, lines 41-43, renders obvious delivering information services according to criteria (*i.e.*, frequency or schedule) established by the subscriber or that Kung suggests anything of the sort at Figs. 7a and 7b.

¹ Claims 1, 16, and 27 recite this limitation verbatim. Claim 38 recites, "storing the selection of information services ... as a subscriber profile."

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In particular, McLeod delivers information services to a user upon their being selected by the user from an audible menu at the time the services are desired. Kung delivers advertisements to the user according to the user's income, age, or other profile as correctly summarized by the Examiner in the Examiner's Answer. Thus, neither create a subscriber profile that includes the subscriber's selected information services (*i.e.*, that the subscriber selects and which are stored before the subscriber goes off hook).

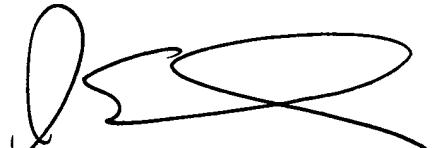
As to a schedule or frequency for delivering information services, McLeod teaches scheduling a conference call while Kung suggests a "chase me" schedule. Neither have anything to do with defining the timing for the delivery of information services.

Even if, however, all claim limitations were taught by the cited prior art, the Examiner has yet to cite a reference in the prior art that suggests or motivates one to combine the prior art teachings to produce the claimed invention. This failure is sufficient unto itself to render all claims allowable.

CONCLUSION:

Appellants again respectfully request the Board of Patent Appeals and Interferences rule that claims 1-5, 8-16, 19-27 and 30-38 are patentable over the cited art for at least the reasons provided above.

Respectfully submitted,



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